

REMARKS

In the outstanding office action, claims 11, 13-14 and 17 were rejected as anticipated by U.S. Patent No. 4,298,123 to Roccaforte et al. ("Roccaforte"); claims 11-14 and 16-17 were rejected as anticipated by U.S. Patent No. 4,998,656 to Hurh ("Hurh"); claims 11-17 and 19-25 were rejected as anticipated by U.S. Patent No. 6,564,942 to Shiffler et al. ("Shiffler"); and claim 18 was rejected as obvious over any one of Roccaforte, Hurh and Shiffler in view of U.S. Patent No. 5,020,664 to Hughes et al. ("Hughes"). By way of this amendment, claims 11-18 have been cancelled and claim 19 has been amended to better define the pending subject matter over the cited art. In addition, claims 22 and 23 have been amended to correct antecedent basis issues. Accordingly, claims 19-25 remain pending and at issue.

First with regard to the rejections under 35 USC §112, claims 22 and 23 have been amended to correct the noted antecedent basis issues and now particularly point out and distinctly claim the subject matter which the applicants regard as the invention. The section 112 rejections thereof should thus be withdrawn.

Turning now to the prior art rejections, the apparatus claims have been cancelled for further prosecution within related patent application no. 09/993,309. This is in addition to apparatus claims already issued in the parent application now issued as U.S. Patent No. 6,564,942. Accordingly, now all that remains pending in this application are the method claims, i.e., claims 19-25.

In the outstanding office action, such claims were rejected as anticipated under 35 USC §102(e) under Shiffler, *et al.*, the aforementioned U.S. Patent No. 6,564,942. However, claim 19 has been amended to recite a method of assembling a film dispenser including the steps of, *inter alia*, folding at least one flap against a false wall, each false wall including wedge shaped braces. Support for such a claim limitation is found throughout the application, for example, at page 6, lines 22-24.

Shiffler, *et al.* fails to disclose such an element. As the retaining wall of Shiffler, *et al.*, is substantially parallel to the end walls of the dispensing carton, its braces are provided orthogonally thereto, and its braces thus are not provided in a wedge shape. In light of this,

Shiffler, *et al.* fails to disclose each and every element of the pending claims and thus fails to anticipate the pending claims.¹

In addition, while not raised by the Examiner, applicants wish to point out at this time so as to prevent unnecessary further prosecution, that Shiffler, *et al.* also is not properly citable against such subject matter under 35 USC §103 on obviousness grounds as well. As stated in 35 USC §103(c), subject matter developed by another person which qualifies as prior art only under 35 USC §102(e), shall not preclude patentability under §103 were the subject matter and the claimed invention are, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. As the pending application is a Continuation-in-Part (CIP) of the cited Shiffler, *et al.* reference, and includes additional inventors, it is properly citable as prior art under §102(e) as subject matter developed by another person. However, it is not properly citable under any other section of §102, and as Shiffler, *et al.* is assigned to S.C. Johnson Home Storage, Inc., the same assignee as the pending application, §103(c) precludes application of the Shiffler, *et al.* reference against the pending subject matter and under obviousness grounds. Accordingly, not only is the pending subject matter not anticipated by the Shiffler, *et al.* reference, but also not obviated by Shiffler, *et al.* as well.

In light of all the foregoing, applicant respectfully submits that each of the pending claims, i.e., claims 19-25 are in condition for allowance, and respectfully requests same. Should the Examiner have any questions, he is invited to telephone the undersigned.

Dated: September 23, 2004

Respectfully submitted,

By 

Thomas A. Miller

Registration No.: 40,091

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicant

¹ Anticipation under 35 USC §102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. "*Rockwell International Corp. v. United States* 47 USPQ2d 1027 (Fed. Cir. 1998).